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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,235	10/20/2000	James G. Clough	09166/002001	8568

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EXAMINER	
MOHANDESI, JILA M	
ART UNIT	PAPER NUMBER
3728	15

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K

Office Action Summary	Application No.	Applicant(s)	
	09/693,235	CLOUGH, JAMES G.	
	Examiner	Art Unit	
	Jila M Mohandesi	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1- 3, 6 and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Rothbart (6,092,314). Rothbart `314 discloses an orthopedic appliance, comprising a wedge (60) for placement under the phalanges of a toe (see column 3, lines 64-65 and Figure 5 embodiments), the wedge having a top surface adapted to support the toe and a lower surface, wherein an angle of inclination between the top surface and the bottom surface is between 1 and 60 degrees. See Figures 7A-7D embodiments.

All the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed, "*Ex parte Masham* 2 USPQ2nd 1674. Also *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something

disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

With respect to claims 3 and 13 and the support being formed integrally, see column 7, lines 45-48.

With respect to claims 6 and 14 and the concave depression, see Figure 8 embodiment and column 7, lines 1-3.

3. Claims 1, 5,and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Tager (4,33,472).Tager `472 discloses an orthopedic appliance, comprising a wedge (resilient foam 10) for placement under the phalanges of a toe (see Figure 3 embodiment and column 4, lines 33-37), the wedge having a top surface adapted to support the toe and a lower surface, wherein an angle of inclination between the top surface and the bottom surface is between 1 and 60 degrees.

All the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed, "*Ex parte Masham* 2 USPQ2nd 1674. Also *Ex parte Casey* 152 USPQ

235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.,* 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims, 4 and 5 are rejected under 35 U.S.C. 103(a) as being obvious over Rothbart `314. With respect to claims 4 and 5 which further limits the material of the orthopedic appliance, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the orthopedic appliance from different material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

6. Claims 7-9 and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothbart `314 in view of either Brock `927 or Jacoby `046. Rothbart `314 as described above discloses all the limitations of the claims except for the orthopedic appliance having a fastener. Each of Brock `927 and Jacoby `046 disclose fastening an orthopedic appliance to the toe of a wearer to better secure and hold the appliance to the toe of the wearer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide fasterner to the orthopedic appliance of Rothbart `314, as taught by each of Brock `927 and Jacoby `314 to better secure and hold the orthopedic appliance to the toe of the wearer.

Claims 18-23 are directed to the obvious method of using the orthopedic appliance of Rothbart `314.Rothbat `314 discloses providing a wedge (10) having a top surface positioned substantially under the phalanges of a toe and a bottom surface; and elevating the toe to a predetermined angle of inclination using the wedge. Rothbart `314 as modified above discloses fixing the wedge to the toe using a fastener.

7. Claims 7-9 and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tager `472 in view of either Brock `927 or Jacoby `046. Rothbart `314 as described above discloses all the limitations of the claims except for the orthopedic appliance having a fastener. Each of Brock `927 and Jacoby `046 disclose fastening an orthopedic appliance to the toe of a wearer to better secure and hold the appliance to the toe of the wearer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide fastener to the

orthopedic appliance of Tager `472, as taught by each of Brock `927 and Jacoby `314 to better secure and hold the orthopedic appliance to the toe of the wearer.

Claims 18-23 are directed to the obvious method of using the orthopedic appliance of Tager `472. Tager `472 discloses providing a wedge (10) having a top surface positioned substantially under the phalanges of a toe and a bottom surface; and elevating the toe to a predetermined angle of inclination using the wedge. Tager `472 as modified above discloses fixing the wedge to the toe using a fastener.

With respect to claim 21, Tiger `472 discloses fixing the bottom surface of the wedge to a piece of footwear (see column 3, lines 22-25).

Response to Arguments

8. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (703)305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

J. MOHANDESI
PATENT EXAMINER

Jila M Mohandesi
Examiner
Art Unit 3728

JMM
April 22, 2003